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APR 30 2002
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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Date: 01 Apr 2002

To: Tim Scott	From: Jon P. Weber, Ph.D.
Application/Control Number: 09/746,921	Art Unit: 1651
Fax No.: 713-561-6380	Phone No.: 703-308-4015
Voice No.: 713-561-6374	Return Fax No.: 703-872-9306
Re:	CC:
<input checked="" type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input type="checkbox"/> For Reply <input checked="" type="checkbox"/> Per Your Request	

Comments:

Courtest copy of Restriction Election of 01 November 2001 is enclosed as well as Interview Summary explaining how time period for reply to Non-responsive letter of 14 February 2002 is being reset.

Number of pages 7 including this page

STATEMENT OF CONFIDENTIALITY

This facsimile transmission is an Official U.S. Government document which may contain information which is privileged and confidential. It is intended only for use of the recipient named above. If you are not the intended recipient, any dissemination, distribution or copying of this document is strictly prohibited. If this document is received in error, you are requested to immediately notify the sender at the above indicated telephone number and return the entire document in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231



Interview Summary

Application No.

09/746,921

Applicant(s)

THORNE ET AL

Examiner

Jon P. Weber, Ph.D.

Art Unit

1651

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All participants (applicant, applicant's representative, PTO personnel):

(1) Jon P. Weber, Ph.D.

(3) _____

(2) Tim Scott

(4) _____

Date of Interview: 01 April 2002

Type: a) ☒ Telephonic b) ☐ Video Conference
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☒ Yes e) ☐ NoIf Yes, brief description: Faxed copy of Restriction election of 01 Nov 01COPY OF PAPERS
ORIGINALLY FILEDClaim(s) discussed: noneIdentification of prior art discussed: noneAgreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The non-responsive letter mailed 14 Feb 2002, was inadvertently sent as non-bona fide. It should have been sent as bona fide. Accordingly, the response period to reply to that letter is hereby reset to begin 14 Feb 2002, and not continue running from the date of mailing of the Restriction Election of 01 Nov 2001. Applicant still has one month to reply to that letter which is extendable under 37 CFR 1.136(a)

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Office Action Summary

APR 30 2002

Application No.

09/746,921

Applicant(s)

THORNE ET AL

Examiner

Harry J. Guttman

Art Unit

1651

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

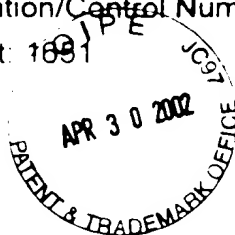
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Application/Control Number: 09/746,921

Art Unit: 1601

MAY 02 2002

Page 2



DETAILED ACTION

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Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a bone growth composition, classified in class 424, subclass 94.1, for example.
- II. Claims 11-14, drawn to a process for making a bone growth composition, classified in class 424, subclass 606, for example.
- III. Claims 15-23, drawn to a process for inducing bone formation, classified in class 623, subclass 11.11, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I or III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are not disclosed as capable of use together since the process of Group II does not require the substrate or bone growth protein present in Group I or III and the inventions have different functions.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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Application/Control Number: 09/746,921
Art Unit: 1651

Page 3

process of using that product (MPEP § 806.05(h)). In the instant case, the invention of Group I could be used as a growth medium for bacteria.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions I and III are generic to a plurality of disclosed patentably distinct species comprising a number of bone growth proteins. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (i.e., **Applicant must choose a single bone growth protein**), even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Application/Control Number: 09/746,921
Art Unit: 1651

Page 4

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

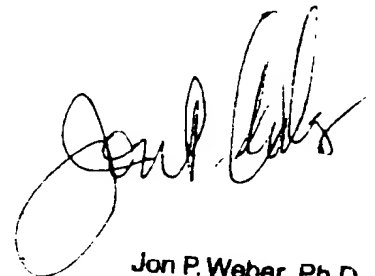
Any inquiry concerning this communication should be directed to Harry J. Guttman, Ph.D. at telephone number (703) 305-0159. The examiner can normally be reached during the hours of 07:30 to 16:00 Eastern Time, Mon.-Thurs. If attempts to reach the examiner by telephone are unsuccessful, a message may be left on the voice mail. The fax number for Art Unit 1651 is (703) 308-4242 or 305-3014. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. My supervisor, Michael Wityshyn, may be contacted at (703) 308-4743.

All internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified or exchanged unless there is of record an express waiver of the confidentiality requirements of 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published in the Patent and Trademark Office Official Gazette on 25 February 1997 at 1195 OG 89.

H.J.G. 31 October 2001



Harry J. Guttman, Ph.D.
Examiner, 1651
harry.guttman@uspto.gov



Jon P. Weber, Ph.D.
Primary Examiner

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Group Vice President
& General Counsel

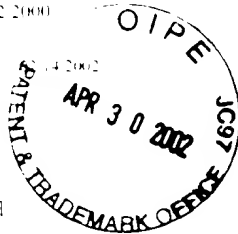
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Washington, DC 20590

361-073

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	COMPONENT NO.
09/746,921	12/22/2000	Kevin J. Thorne	2265-15	2764

REMARK OFFICE 169
102

Timothy L. Scott, Esq.
Sulzer Biologics Inc.
Suite 1600
3 East Greenway Plaza
Houston, TX 77046-0391



EXAMINER

GUTTMAN HARRY J

ART UNIT PAPER NUMBER

DATE MAILED 02/14/2002

Please find below and or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Washington, D.C. 20231

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER

8

DATE MAILED:

Do not file this as a final

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

The reply filed on December 20, 2001 is not fully responsive to the prior Office Action because: a species election was improperly made. Applicant is directed to the bold face type in the middle of page 3 that gives explicit direction to choose a SINGLE BONE GROWTH PROTEIN. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

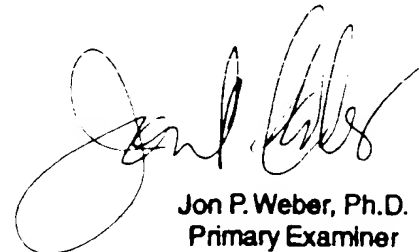
The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Any inquiry concerning this communication should be directed to Harry J. Guttman, Ph.D. at telephone number (703) 305-0159. The examiner can normally be reached during the hours of 07:30 to 16:00 Eastern Time, Mon.-Thurs. If attempts to reach the examiner by telephone are unsuccessful, a message may be left on the voice mail. The fax number for Art Unit 1651 is (703) 308-4242 or 305-3014. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. My supervisor, Michael Wityshyn, may be contacted at (703) 308-4743.

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H.J.G. 13 February 2002

Harry J. Guttman, Ph.D.
Examiner, 1651
harry.guttman@uspto.gov


Jon P. Weber, Ph.D.
Primary Examiner

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Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.